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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,438	07/26/2001	Rabindranath Dutta	AUS920010422US1	7369
34533	7590	12/09/2004	EXAMINER	
IBM CORP (BLF) c/o BIGGERS & OHANIAN, LLP 504 LAVACA STREET, SUITE 970 AUSTIN, TX 78701-2856			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,438

Applicant(s)

Dutta et al.

E

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on August 17, 2004.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-60 is/are pending in the application.
 - 4a) Of the above claim(s) 21-60 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20011218 and 20040312
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Invention I (Claims 1-20) on August 17, 2004 is hereby acknowledged. The traversal is on the ground(s) that:

- The three inventions are not "independent and distinct";
- The process of Invention I and the apparatus of Invention II "are not related as process and apparatus";
- The process of Invention I and the apparatus of Invention III "are not related as process and apparatus";
- The combination of Invention II (computer + computer program) and the subcombination of Invention III (computer program) "are not related as combination and subcombination";
- The subcombination of Invention III has no separate utility from the combination of Invention II because many other subcombinations share the same separate utility";
- Inventions I, II, and III are not separate in the art;
- Inventions I, II, and III are not distinct; and,
- All three inventions could be examined without serious burden on the examiner;

2. Applicant's arguments have been fully considered but are not found persuasive.

3. Regarding the argument that the three inventions are not “independent and distinct,” the requirement for restriction made no such statement, thus the argument has been deemed merely spurious, therefore disregarded.

4. Regarding the argument that Invention I is not related to Invention II as process and apparatus for its practice because, since some steps of the process require the use of apparatus, all steps must make use of apparatus, applicant’s argument has been disregarded as specious, since such is obviously not the case, and in any event, applicant has utterly failed to provide any cogent rationale as to why the exemplary step cited by the examiner could not be performed manually in the manner described.

5. Regarding the argument that Invention I is not related to Invention III as process and apparatus for its practice because Invention III is not apparatus, Invention III is indeed apparatus. Processes are steps performed or actions taken (i.e., verbs), whereas apparatus are objects or things (i.e., nouns). As “a computer program product, a computer program recorded on a recording medium” (as applicant characterizes Invention III in applicant’s remarks) is indeed a thing, not a step, Invention III is indeed apparatus. Therefore, as Invention I is a process and Invention III is apparatus, and as the apparatus of Invention III performs the process of Invention I, Invention I is indeed related to Invention III as process and apparatus for its practice.

6. Regarding the argument that the combination of Invention II (computer + computer program) and the subcombination of Invention III (computer program) are not related as combination and subcombination because a “computer program recorded on a recording medium is not an element or part of a computer system,” yes, a computer program recorded on a recording medium is indeed an element or part of a computer system.

7. Regarding the argument that the subcombination of Invention III has no separate utility from the combination of Invention II because many other subcombinations share the same separate utility, the argument has been dismissed as irrelevant. Additionally, the examiner notes that the subcombination of Invention III has many other excellent separate utilities as well, including, but not limited to, frisbees and coasters.

8. Regarding the argument that the three inventions are not separate in the art because they are all three classified in class 707, subclass 100, the argument has been deemed spurious, thus disregarded, since classification of subject matter is properly performed by the Office, not by applicants, and the proper classification was provided to applicant in the previous Office action. Notably, none of the three inventions are properly classified as suggested by applicant.

9. Regarding the argument that the three inventions are not distinct because an apparatus claim to “means” for practicing a process is a linking claim and must be examined together with

the process claim (inexplicably contravening applicant's earlier argument that the apparatus is *not* apparatus), the argument has been disregarded as irrelevant, since applicant has no such claim.

10. Regarding the argument that all three inventions could be examined together with no additional burden on the examiner, MPEP § 803 states, in part, under "Guidelines":

A serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant.

11. As the examiner has indeed made such a *prima facie* showing of serious burden, based upon separate classification, as set forth in the Requirement for Restriction (Paper N^o 7), and as applicant has offered no "showing or evidence" in rebuttal to that conclusion, simply an opinion stating a contrary position, applicant's arguments have been dismissed as merely spurious, amounting to simply a general allegation that a serious burden would not be imposed, without specifically pointing out how the language of the claims fails to comport with the explanation of separate classification provided by the examiner.

12. The restriction requirement is still deemed proper and is therefore made FINAL.

13. Claims 21-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction requirement in the election submitted August 17, 2004.

Claim Objections

14. Claims 5, 15, and 16 are objected to because of the following informalities: it appears that “The method of claim 1” (line 1 of each claim) was intended to be, respectively: --The method of claim 4--; --The method of claim 4--; and, --The method of claim 5--, which changes will be assumed for purposes of further consideration of the claims hereinafter. Appropriate correction is required.

15. Claim 18 is objected to because of the following informalities: it appears that “wherein validating the related customs planning records” (line 1) was intended to be --wherein validating goods described in a related customs planning record-- (as in claim 17, from which claim 18 depends); and, that “the goods described by customs data” (two places: line 2 and lines 3 and 4) was intended to be --the goods described-- (as in claim 17, from which claim 18 depends), which changes will be assumed for purposes of further consideration of the claims hereinafter.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-6 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al. (US 6,460,020).

Regarding claims 1, 2, 12, and 13, Pool et al. disclose a method for facilitating customs planning and clearance, the method comprising the steps of: creating a master customs planning record and a related customs planning record in at least one international customs server, in response to signals communicated through a client device coupled for data communications through at least one Internet connection to the at least one international customs server, and the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise, but Pool et al. do not specifically disclose that the respective customs planning records each individually comprise all of the specific data elements, as claimed. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have arranged any of the calculated and stored data elements of Pool et al. so as to be stored in the specific arrangement/manner of the instant claims, simply as a matter of design choice, since so doing could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 3, each related customs planning record of the method of Pool et al. represents a prospective importation into a destination country of a quantity of goods of a category.

Regarding claims 4-6, the method of Pool et al. further comprises creating, in dependence upon the related customs planning record, a customs declaration form for a destination country, submitting the form to a customs declaration forms database for the destination country, and submitting, to the customs service of the destination country, payment of the duty.

Regarding claim 11, Pool et al. disclose that the at least one Internet connection can be wireless.

Regarding claim 14, the method of Pool et al. further comprises that the international customs server is a software application installed and operating on one or more computers, the software application further comprising software routines storing and retrieving related customs planning records, validating goods described in related customs planning records against customs regulations stored in customs regulations databases, and submitting to customs databases declaration forms prepared in dependence upon the related customs planning records.

Regarding claim 15, the method of Pool et al. includes that creating in dependence upon the related customs planning record a customs declaration form for the destination country further comprises reading customs data from a related customs planning record and inserting the read customs data into a declaration form.

Regarding claim 16, the method of Pool et al. further includes that submitting the customs declaration form to a customs declaration forms database for the destination country further comprises communicating the form as electronic data communications through at least one Internet connection.

Regarding claim 17, the method of Pool et al. further comprises validating goods described in a related customs planning record by comparing the goods described by customs data in the related customs planning record to customs regulations governing the goods described by the customs data in the related customs planning record, storing the result of the comparison in the related customs planning record, and reporting to an importer through the client device a result of the comparison.

Regarding claim 20, the method of Pool et al. further comprises that the related customs planning record comprises a related customs planning record form having a structure, wherein the structure of the related customs planning record form is dependent upon customs regulations.

18. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al. as applied to claim 1 above, and further in view of Seigel et al. (US 2001/0051876).

Pool et al. disclose a method for facilitating customs planning and clearance, as applied above to claim 1, but Pool et al. fail to disclose the client device as specifically being any of: a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal computer; or, a hand-held personal data administrator (PDA).

However, Seigel et al. disclose a similar method that also requires accessing the Internet, as does the method of Pool et al., and the method of Seigel et al. specifically discloses that the client device used to access the Internet can indeed be any of: a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal

computer; or, a hand-held personal data administrator (PDA). See, in particular, paragraphs 16 and 60-62.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Pool et al. so as to use a client device comprising any of a workstation in a kiosk at an airport; a workstation installed in the back of a passenger chair in an airplane; a personal computer; or, a hand-held personal data administrator (PDA), in accordance with the teachings of Seigel et al., in order to provide easy and convenient access to the Internet.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to the disclosure.

20. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

October 29, 2004

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", with the date "(11-15-04)" written to its right.

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627